

*B7*  
*and*

a display;  
a processor operatively coupled to said display, including random output means appearing on said display, resulting in a plurality of outcomes; means for accepting a target outcome from a player, said target outcome chosen by the player independently of the gaming device; means for comparing each of said plurality of outcomes to said target outcome; and award means for awarding a player if any of said plurality of outcomes matches said target outcome.

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#### REMARKS

The Office Action dated June 4, 2002 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art and certain typographical inexactitudes have been rectified to provide better form. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

**Election**

With respect to the requirement for election and restriction between groups I and II, applicant hereby provisionally elects group I, consisting of claims 1 through 23. Applicant traverses the restriction requirement of groups I and II and requests reconsideration.

It is respectfully stipulated that claims 24 and 25 are so closely related to claims 1 through 23 that they should remain in the same application to preserve unity of the invention and thus avoid any possibility of the charge of double patenting arising at some later date. Each of the above-identified claims is directed to a gaming device having concurrent games and to the methods and apparatus employed therein.

The statutory requirement under 35 U.S.C. §121 that there be both independence and distinction between the inventions has not been met. The Examiner has not set forth with specificity what is believed to be the distinction to be between the groups. Therefore, the Examiner is respectfully requested to withdraw the restriction requirement between groups I and II. Although claims 24 and 25, constituting group II, has not been provisionally elected, applicant still reserves the right to file a divisional application for this subject matter and applicant does not waive any right therefore or abandon such subject matter.

**Rejections under 35 U.S.C. § 103**

The Examiner has rejected claims 1 through 7 and 9 through 23 under 35 U.S.C. § 103(a) as being unpatentable over Falciglia '002 in view of Tsumura '202.

Falciglia discloses a bingo-type game, in which all indicia displayed on the random selection areas of the machine are related to the bingo game (e.g., col. 4 lines 19-28; col. 6, lines 48-58). Tsumura teaches saving a game state for a non-wager machine (col. 11, lines 33-54).

With regard to claims 1 through 4, the Examiner asserts at page 3 of the Office Action that Falciglia teaches triggering a subsequent event at column 6, lines 3-22. Falciglia teaches no such thing. At this point in the patent, Falciglia lists the various awards available for positions matched on the playfield. The awards are tallied to produce a final award at the end of the game. Claim 1 requires "triggering a subsequent event *if any of the plurality of outcomes matches the ultimate winning outcome*". The limitation of "an ultimate winning outcome" as a triggering condition is not present in Falciglia. This limitation is also missing from Tsumura, and thus, the rejection under 35 U.S.C. § 103 should be withdrawn.

In addition, the Examiner merely asserts at page 4 of the Office Action that the combination of Falciglia with Tsumura would have been obvious at the time the invention was made. No objective evidence or reasoning is given. The passage cited by the Examiner as evidence of motivation in Tsumura, column 11, lines 29-32, merely describes how the saving is done, and provides no motivation whatsoever for combining references. The Examiner seems to assert that even though Tsumura does not provide for wagers, the distinction is irrelevant. Undersigned respectfully submits that such a combination would not be obvious because of the nature of casino-style gaming. Wager games in the art are designed to keep players gaming at their

machines. Falciglia simply does not contemplate allowing a player to stop gaming and then to resume the same game at a later time, and no motivation exists to combine references, such as Tsumura, including such a feature. This reasoning applies to all of the claims of the present invention, necessitating the withdrawal of the rejection under 35 U.S.C. § 103.

With regard to the Examiner's statement at page 6 of the Office Action, Falciglia in fact only allows a player to move randomly generated outcomes to the matrix playfield (col. 2, lines 19-22; col. 30-36). The player does not independently choose any outcomes in Falciglia, unlike the choice of outcomes offered in the potential subsequent gaming event of the present invention.

Finally, at page 6 of the Office Action, the Examiner cites *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) for the proposition that motivation or suggestion to combine references may be gleaned from knowledge generally available to one of ordinary skill in the art. The Examiner has omitted the additional teachings from those cases that require evidence, that is, "support or explanation" other than a mere "bald assertion" for the conclusion that a piece of knowledge is generally available to one skilled in the art, *Fine*, 5 USPQ2d at 1599. In the present case, the Examiner states various conclusions without support or evidence other than a subjective perception of what was known in the art at the time the invention was made. Rejection under 35 U.S.C. § 103 is therefore improper, because a *prima facie* case of obviousness has not been made.

Undersigned has read these patents carefully and has failed to uncover the basis by which the Examiner has combined these references to support an obviousness type rejection. Stated alternatively, there is no teaching within these citations that would warrant the combination of elements proposed by the Examiner, and it is respectfully stipulated that applicant's structure would still not be obtained thereby. A specific teaching within one of the references suggesting the combination is required:

"To reject claims in an application under Section 103, an Examiner must show an unrebutted *prima facie* case of obviousness. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. . . . When a rejection depends on a combination of prior art references there must be some teaching, suggestion, or motivation to combine the references. . . . To prevent the use of hindsight based on the invention to defeat patentability of the invention, this Court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455-1458 (CAFC 1998) (citations omitted).

"Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination." *Lindemann Mashinenfabrick GmbH v. American Hoist and Derrick Co.*, 780 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992)

"In determining the propriety of a rejection under 35 U.S.C. § 103, it is well settled that the obviousness of an invention cannot be established by combining the teachings of the prior art absent some teaching, suggestion or incentive supporting the combination. . . . [I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together isolated disclosures and teachings of the prior art so that the claimed invention may be rendered obvious. We additionally note that a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply the deficiencies in the factual basis." *Ex parte Haymond*, 41 U.S.P.Q.2d 1217, 1219 - 1220 (Board of Patent Appeals and Interferences 1996) (citations omitted).

Moreover, to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim of the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *W.L. Gore and Associates*,

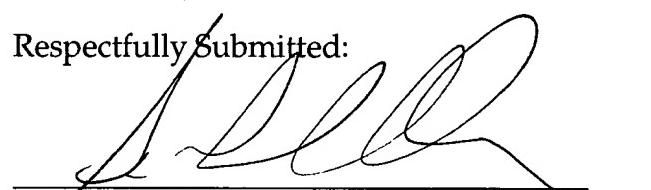
*Inc. v. Garlock, Inc.* 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The claims have been amended hereinabove to make explicit the existence of concurrent games of the present invention in addition to a potential subsequent game that may be offered. In addition, the fact that the player's choice of outcomes is independent of the gaming device of made explicit. No reference teaches the combination of elements and limitations of the instant invention.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

Dated: December 4, 2002

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**Bracketed and Underlined Claims under 37 C.F.R. § 1.121**

Claim 1 (amended) - A method for gaming, the steps including:

enabling the gaming device upon receipt of a wager,

evoking chance means to produce a plurality of outcomes to be used in a plurality of concurrent[ly] games, at least one of said plurality of concurrent games having an ultimate winning outcome and a plurality of intermediate winning outcomes,

displaying [the] said plurality of outcomes in said plurality of concurrent games,

comparing each of [the] said plurality of outcomes for each of said plurality of concurrent games to [an] said ultimate winning outcome,

triggering an event subsequent to said plurality of current games [event] if any of [the] said plurality of outcomes matches [the] said ultimate winning outcome,

determining whether, if none of [the] said plurality of outcomes matches [the] said ultimate winning outcome, any of [the] said plurality of outcomes matches any of said plurality of intermediate winning outcomes in any of said plurality of concurrent games,

awarding credits if any of [the] said plurality of outcomes matches any of said plurality of intermediate winning outcomes,

continuing to evoke chance means to produce subsequent pluralities of outcomes until said ultimate winning outcome is produced or until said subsequent outcomes are no longer possible, and

saving [the] a current set of said outcomes and said subsequent outcomes on encoded moveable media, said encoded moveable media dispensed to the player for later use.

Claim 2 (amended) - The method of claim 1 [wherein said chance means includes] further including the step of producing randomly-generated numbers corresponding to a randomly-numbered playfield oriented in a row-and-column (RXC) matrix, and wherein [in which] said ultimate winning outcome consists of matching all of said randomly-generated numbers to said randomly-numbered playfield.

Claim 3 (amended) - The method of claim 2 [wherein a plurality of said intermediate winning outcomes are possible by] further including the step of awarding the player for matching a subset of the numbers in said randomly-numbered playfield to said randomly-generated numbers if said ultimate winning outcome is not attained.

Claim 4 (amended) - The method of claim 1 further including the step of configuring [wherein] said subsequent event [is comprised of the] to include the step of awarding [of] credits.

Claim 5 (amended) - The method of claim 1 further including the step of configuring [wherein] said subsequent event [is comprised of the] to include the step of awarding [of] a plurality of complimentary items other than credits.

Claim 6 (amended) - The method of claim 1 further including the step of configuring [wherein] said subsequent event [is comprised] to include the step of engaging in a subsequent gaming event.

Claim 7 (amended) - The method of claim 1 further including the step of configuring [wherein] said subsequent event [comprises] to include the steps of:

awarding credits, and  
engaging in a subsequent gaming event.

Claim 8 (amended) - The method of claim 7 further including the step of configuring [wherein] said subsequent gaming event [comprises] to include the steps of:

allowing a player to select a subset of outcomes from a set of possible outcomes,

generating outcomes,  
comparing [the] said selected subset of outcomes with [the] said generated outcomes, and

awarding credits according to a payable for matches between [the] said selected subset of outcomes and [the] said generated outcomes.

Claim 9 (amended) - The method of claim 7 including the step of configuring said subsequent gaming event [by] to include the step of simulating a racing event.

Claim 10 (amended) - The method of claim 2 further including the step of configuring [wherein] said subsequent event [comprises] to include the steps of:

awarding credits, and  
engaging in a subsequent gaming event.

Claim 11 (amended) - The method of claim 10 further including the step of configuring [wherein] said subsequent gaming event [comprises] to include the steps of:

allowing a player to select a subset of outcomes from a set of possible outcomes,

generating outcomes,

comparing [the] said selected subset of outcomes with [the] said generated outcomes, and

awarding credits according to a payable for matches between [the] said selected subset of outcomes and [the] said generated outcomes.

Claim 12 (amended) - The method of claim 10 further including the step of configuring [wherein] said subsequent gaming event [comprises means for] to include the step of simulating a racing event.

Claim 13 (amended) - The method of claim 3 further including the step of configuring [wherein] said subsequent event [comprises] to include the steps of:

awarding credits, and

engaging in a subsequent gaming event.

Claim 14 (amended) - The method of claim 13 further including the step of configuring [wherein] said subsequent gaming event [comprises] to include the steps of:

allowing a player to select a subset of outcomes from a set of possible outcomes,

generating outcomes,

comparing [the] said selected subset of outcomes with [the] said generated outcomes, and

awarding credits according to a payable for matches between [the] said selected subset of outcomes and [the] said generated outcomes.

Claim 15 (amended) - The method of claim 13 further including the step of configuring [wherein] said subsequent gaming event [comprises means for] to include the step of simulating a racing event.

Claim 16 (amended) - The method of claim [1] 3 wherein only a single player is involved.

Claim 17 (amended) - The method of claim [1] 3 wherein a plurality of players may participate in concurrent gaming sessions in competition with each other.

Claim 18 (amended) - The method of claim 2 further including the step of forming said RXC matrix as a three dimensional array.

Claim 19 (amended) - A gaming device, comprising, in combination:

a display,

a processor operatively coupled to said display, including random output means appearing on said display, resulting in a plurality of outcomes applicable to a plurality of concurrent games,

means for comparing each of said plurality of outcomes to a set of winning outcomes for each of said plurality of concurrent games, said set of winning outcomes including, for at least one of said plurality of concurrent games, an ultimate winning outcome and a plurality of intermediate winning outcomes,

award means evoked if any of said plurality of outcomes matches one of said winning outcomes on any of said plurality of concurrent games, including means to trigger a subsequent gaming event if any of said plurality of outcomes matches said ultimate winning outcome,

continuance means for generating subsequent pluralities of outcomes, and

saving means to store the state of play on encoded moveable media, including means to dispense said encoded moveable media for use at a later time.

Claim 20 (amended) - A method for gaming, the steps including:

enabling the gaming device upon receipt of a wager;

evoking chance means to produce a plurality of outcomes to be used in a plurality of concurrent[ly] games, at least one of said plurality of concurrent games having an ultimate winning outcome and a plurality of intermediate winning outcomes,

' displaying [the] said plurality of outcomes in said plurality of concurrent games,

comparing each of [the] said plurality of outcomes for each of said plurality of concurrent games to [an] said ultimate winning outcome,

triggering an event subsequent to said plurality of current games [event] if any of [the] said plurality of outcomes matches [the] said ultimate winning outcome, wherein said subsequent event comprises:

awarding credits, and

engaging in a subsequent gaming event, wherein said subsequent gaming event comprises:

allowing a player to independently select a subset of outcomes from a set of possible outcomes,

generating outcomes,

comparing [the] said selected subset of outcomes with [the] said generated outcomes, and

awarding credits according to a payable for matches between [the] said selected subset of outcomes and [the] said generated outcomes;

determining whether, if none of [the] said plurality of outcomes matches [the] said ultimate winning outcome, any of [the] said plurality of outcomes matches any of said plurality of intermediate winning outcomes;

awarding credits if any of [the] said plurality of outcomes matches any of said plurality of intermediate winning outcomes;

continuing to evoke chance means to produce subsequent pluralities of outcomes until said ultimate winning outcome is produced or until said subsequent outcomes are no longer possible; and

saving [the] a current set of said outcomes and said subsequent outcomes on encoded moveable media, said encoded moveable media dispensed to the player for later use.

Claim 21 (amended) - The method of claim 7 further including the step of configuring said subsequent gaming event as Keno.

Claim 22 (amended) - A method for gaming, the steps including:

enabling ~~the~~<sup>1</sup> gaming device upon receipt of a wager;  
receiving from ~~the~~<sup>1</sup> player a target outcome, wherein the player chooses said target outcome independently of said gaming device;

generating outcomes;

comparing [the] said generated outcomes with [the] said target outcome;  
and

awarding credits according to a payable, should [the] said generated outcome match [the] said target outcome.

Claim 23 (amended) - A gaming device, comprising, in combination:

a display;

a processor operatively coupled to said display, including random output means appearing on said display, resulting in a plurality of outcomes;

means for accepting a target outcome from a player, said target outcome chosen by the player independently of the gaming device;

means for comparing each of said plurality of outcomes to said target outcome; and

award means for awarding a player if any of said plurality of outcomes matches said target outcome.